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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/132,231	08/11/1998	MARSHALL S. HORWITZ	032425-001	9035

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EXAMINER

BRUSCA, JOHN S

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 08/12/2003

51

Please find below and/or attached an Office communication concerning this application or proceeding.

Art Unit: 1631

The fact pattern set forth in your e-mail of July 21, 2003 has been reviewed.

The time period for response has been reset to expire 6 months from July 17, 2003.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Woodward whose telephone number is (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Michael P. Woodward
SPE AU 1631
Technology Center 1600

PART 4 OF 5

Woodward, Michael

From: Sharonc@burnsdoane.com
Sent: Monday, July 21, 2003 5:59 PM
To: Michael.Woodward@uspto.gov
Cc: Dannyh@burnsdoane.com; John.Brusca@uspto.gov; John.Doll@uspto.gov
Subject: 09/132,231 filed August 11, 1998

SPE Woodward-

I attempted to leave you a voicemail message today, but it cut me off in the middle of my discussion. Therefore, I am confirming with this email message, as well as completing the discussion of why I would like to talk to you.

As you may recall, prior to filing the CPA, we had been given a 6 month period in which to provide 1.608(b) declarations in support of our Request for Interference. (Note that the communication dated November 15, 2002 did not indicate a time period for response - rather, Examiner Brusca indicated in a phone conversation that this would be the case.)

Our client and the potential opponent had begun talks to possibly settle this matter in advance of filing the 1.608(b) declarations. Because these settlement discussions were ongoing at the 6 month response date, we filed a CPA in this application on May 15, 2003.

I was contacted by Examiner Brusca in late June, at which time he requested that we provide a courtesy copy of the CPA papers, because the papers we filed in May had not yet been matched up with the case. Because our client was unsure how long it would take to complete the settlement, they asked me to tell Examiner Brusca that we would rather wait until the papers were matched up. I asked Examiner Brusca at that time what sort of response period we would have once he received the papers, and he indicated he would issue an Office Action giving us a 3 month period for response, and then 3 additional months for extensions would apply.

In reliance on this information, our client then instructed us to provide Examiner Brusca with the courtesy copy of the CPA papers, which we did on July 10, 2003. On July 17, 2003, I called Examiner Brusca to confirm his receipt of the papers, and find out when he would be acting on the case. He indicated that he had already issued a Communication (rather than the promised Office Action), again requiring us to provide the 608(b) declarations, but in contrast to the Communication prior to filing the CPA, gave us only 1 month in which to respond, with no possibility of extensions.

It was our understanding when we filed the CPA that we would receive a requirement for filing the 608(b) declarations which was similar in response time period to that which we received prior to filing the CPA. Whether it had been in the form of a Communication or an Office Action as promised by Examiner Brusca, we relied on the fact that we would have 6 months in which to respond. Otherwise, we would not have provided the courtesy copy to Examiner Brusca, and would possibly have been able to complete our settlement discussions by the time the papers were matched up. As it is, there is essentially no chance of completing the settlement discussions prior to the due date for filing the 608(b) declarations. This will result in significant costs to both parties, as well as the PTO, which possibly could be avoided if the parties have the promised 6 months in which to respond.

If a Communication is indeed the proper paper to be issued in this case, wouldn't it be proper for it to give us the same 6 month period in which to respond that we had previously, or at least the one month period plus an additional 5 months of extension available? Another alternative would be for us to provide the above information concerning settlement discussions in the form of a Request for Extension of Time Pursuant to 1.136(b).

In any event, we would appreciate your assistance in providing the additional time for settlement discussions to proceed.

Thank you in advance for your consideration of this matter.

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